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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,863	03/31/2004	Edward Vaquero	P03166	5586
23702 7590 07/06/2010 Bausch & Lomb Incorporated One Bausch & Lomb Place Rochester, NY 14604-2701				
EXAMINER				
LANG, AMY T				
ART UNIT		PAPER NUMBER		
3731				
MAIL DATE		DELIVERY MODE		
07/06/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/813,863

Applicant(s)

VAQUERO, EDWARD

Examiner

AMY T. LANG

Art Unit

3731

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 4, 6-13 and 22-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 6-13, and 22-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The indicated allowability of claims and 23-25 is withdrawn in view of the newly discovered reference(s) to Swick (US 2003/0233078 A1). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 1, 3, 4, 6-13, and 22-25** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 23 there is an inconsistency making the scope of the claim unclear. In lines 8-9 of claim 1, Applicant recites "configured ... to permit placement ... in a loading bay" with the loading bay only being functionally claimed. However, in lines 9-11, Applicant seems to positively recite the loading bay since its location is used as a reference for the lumen diameter. Similarly, claim 23 seems to only functionally claim the loading bay in lines 6-7 with "sized and shaped to receive the IOL into a loading bay." However, line 9 of claim 23 seems to positively recite the loading bay since the IOL is disposed within this element. Therefore, it is unclear if Applicant intends to positively claim the loading bay or not. Applicant is hereby required to indicate to which the claims are intended to be directed and amend the claims such that the language

thereof is consistent with this intent. Claims 3, 4, 6-13, 22, 24, and 25 are dependent on claims 1 and 23 and therefore are also considered indefinite.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

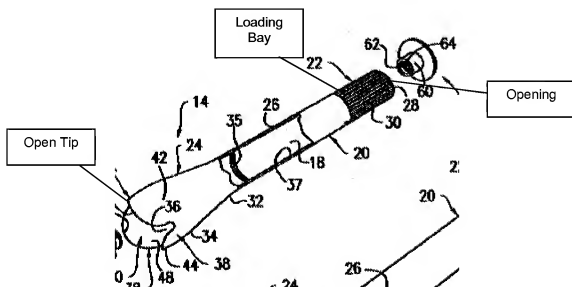
A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1, 3, 4, 6-13, and 22-25** are rejected under 35 U.S.C. 102(e) as being indefinite by Swick (US 2003/0233078 A1).

With regard to **claims 1 and 23**, Swick discloses a device comprising an injector body (14) having internal lumen (18) ([0018]; [0019]). As shown in Figure 1, the lumen is sized to permit transport of an IOL therethrough. Additionally, the lumen is configured such that it comprises a proximal opening, a loading bay just distal of this opening, and a distal open tip (shown below). Since the opening opens into the loading bay, the opening is configured and arranged to permit placement of an IOL into a loading bay. Furthermore, the inner diameter of the lumen at a location immediately adjacent and distal to the loading bay is less than an inner diameter of the lumen at the open tip ([0019]). It is also the Examiner's position that plunger (16) overlaps the claimed compressor since it is connected to the injector body at a location proximate the

opening (Figure 2) and is configured and arranged to compress an IOL (Figure 6; [0024]; [0025]).



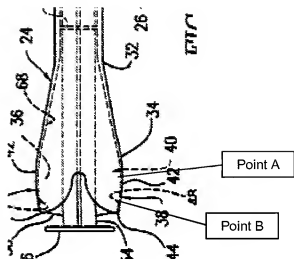
Conversely, it is also the Examiner's position that the proximal opening, as shown above, overlaps the claimed opening and intermediate cavity section (84) of the packing assembly (70) overlaps the claimed loading bay ([0028]). It is noted that the instant claims do not require the loading bay to be within the device. The opening is configured to permit placement of the IOL in the device so that the IOL can be ejected out from the open tip into the loading bay (84) (Figure 4). Although Swick does not specifically disclose such use, the functional limitation "configured to" is not given full patentable weight. As long as the prior art meets the structural requirements and is capable of performing the functions, the prior art meets the limitations. Furthermore, the inner diameter of the lumen at a location immediately adjacent and distal to the loading

bay (component 26 in Figure 4) is less than an inner diameter of the lumen at the open tip (36). Component 26 in Figure 4 is adjacent to the loading bay since it is close to the loading bay, especially when the injector is placed within the packing assembly (Figure 3).

With regard to **claims 3 and 22**, the compressor (16) comprises a leading edge (66) and is moveable to a closed position wherein the compressor can engage an IOL (Figures 12 and 11).

With regard to **claims 4 and 24**, it is also the Examiner's position that platform (58) overlaps the claimed compressor since it is able to move to a closed position when it contacts the injector body (Figure 5). The compressor (58) is able to compress an IOL between the leading edge, the distal side of the member, and the injector body. Plunger (16) then overlaps the claimed plunger and comprises shaft (50) and tip (66) ([0024]; [0025]).

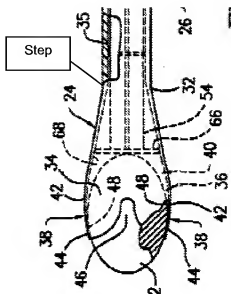
With regard to **claim 6**, as shown in Figure 7, the outer diameter of the injector body has is substantially constant from point A to point B, as shown below. Point A is adjacent the location where the IOL is initially placed since it is close to this location (noting that since the two points are on the same device they are close in location). Point B is the open distal tip.



With regard to **claim 7**, the outer diameter increases along with the outer diameter of the internal lumen (Figure 6).

With regard to **claims 8, 10, and 12**, the lumen gradually increases in diameter (Figure 6).

With regard to **claims 9, 11, and 13**, it is also the Examiner's position that the lumen also includes at least one step in increase, as shown below. Although the entire lumen diameter increases gradually, it still comprises at least one interval increase.



With regard to **claim 25**, it is the Examiner's position that the compressor (16) overlaps the claimed compressor drawer since the leading edge (66) forms a platform and the entire compressor can be pulled in and pushed out of the device (Figures 6 and 7).

Response to Arguments

6. Applicant's arguments with respect to claims 1, 3, 4, 6-13, and 22-25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMY T. LANG whose telephone number is (571)272-9057. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

07/01/2010
/Amy T Lang/
Examiner, Art Unit 3731

/Anhtuan T. Nguyen/
Supervisory Patent Examiner, Art Unit 3731
07/01/2010